

REMARKS

The Examiner is thanked for the performance of a thorough search.

Claims 1-3 and 10-12 have been amended. No claims have been canceled or added.

Hence, Claims 1-32 are pending in the application.

Each issue raised in the Office Action mailed February 13, 2006 is addressed hereinafter.

I. ISSUES NOT RELATING TO THE PRIOR ART

A. OBJECTION TO THE ABSTRACT

The Abstract has been objected to because it exceeded 150 words in length. The abstract is amended herein to 129 words in length.

B. OBJECTIONS TO CLAIMS 17-32

Claims 17-32 have been objected to because of an alleged informality. Specifically, the Office Action asserts that it is unclear whether these claims are in a dependent or independent claim format. Further, based on the alleged informality, the Office Action incorrectly treats Claims 17-32 as independent claims. The objections to Claims 17-32 are respectfully traversed.

With respect to these objections, it is recognized that it is uncommon for a dependent claim to have a different form than the claim on which it depends. However, such a practice is explicitly authorized by the MPEP. In fact, many patents have issued with this exact form of dependent claim, including:

- 6,711,567 Delivering non-default items in association with search results
- 6,661,877 System and method for providing access to a unified message store logically storing computer telephony messages
- 6,647,510 Method and apparatus for making available data that was locked by a dead transaction before rolling back the entire dead transaction
- 6,633,891 Managing replacement of data in a cache on a node based on caches of other nodes
- 6,631,371 Database fine-grained access control
- 6,130,677 Interactive computer vision system
- 6,031,934 Computer vision system for subject characterization

In all of these cases, the USPTO ultimately found the claims to be in proper dependent form. However, due to the uncommon nature of such claims, it was necessary in at least one previous case to set forth a detailed explanation of the propriety of such claims. That argument is reproduced hereafter. It should be noted that the claim at issue in that previous case was a computer-readable medium Claim 7 which depended on an independent method Claim 1. The present Claims 17-32 have the identical form of that prior Claim 7, so the explanation provided hereafter applies equally to the present Claims 17-32.

DETAILED EXPLANATION OF PROPRIETY OF CLAIM 7

Various tests have been established to determine whether a particular claim qualifies as a proper dependent claim. Significantly, none of the tests requires the dependent claim to fall within the same statutory class as the claim on which it depends. Specifically, MPEP § 608.01(n) states, among other things:

“The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.”

TEST #1: CLAIM 7 IS PROPER UNDER 35 U.S.C. § 112

35 U.S.C. § 112 is the statutory section that sets for the requirements of a proper dependent claim. In paragraph 4, 35 U.S.C. § 112 states:

Subject to the following paragraph, a claim in dependent form shall **contain a reference to a claim previously set forth** and then **specify a further limitation of the subject matter claimed.** A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The first sentence of this paragraph sets forth the two requirements for a proper dependent claim, and the second sentence sets forth the legal significance to the dependency.

With respect to the requirements, a proper dependent claim must (1) contain a reference to a claim previously set forth, and (2) specify a further limitation on the subject matter claimed. Both of these requirements are clearly satisfied by Claim 7. Specifically, Claim 7 clearly contains a reference to Claim 1. In addition, Claim 7 specifies the further limitation that instructions for performing the method of Claim 1 must be stored on a computer-readable medium, so that the method would be performed when one or more processors execute the instructions. Since Claim 1 does not itself require that the method be performed by executing stored instructions, the limitation added by Claim 7 qualifies as a further limitation.

Because Claim 7 is a proper dependent claim, the second sentence of 35 U.S.C. § 112, fourth paragraph indicates that it is to be construed to incorporate by reference all the limitations of the claim to which it refers. Thus, in the present case, Claim 7 is to be construed to incorporate all limitations of the method set forth in Claim 1. That interpretation of Claim 7 is consistent with Applicant's understanding of Claim 7. Specifically, to infringe Claim 7, a computer readable medium would have to include instructions for each and every step recited in the parent Claim 1.

TEST #2: CLAIM 7 IS PROPER UNDER 37 C.F.R. § 1.75(c)

37 C.F.R. § 1.75(c) states:

"One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application...."

The test set forth in 37 C.F.R. § 1.75(c) is merely an abbreviated restatement of the test set forth 35 U.S.C. § 112, fourth paragraph. As explained above, Claim 7 refers back to Claim 1, and introduces limitations that are not present in Claim 1. Consequently, Claim 7 satisfies the 37 C.F.R. § 1.75(c) for the same reasons that it satisfies the 35 U.S.C. § 112, fourth paragraph test.

TEST #3: CLAIM 7 IS PROPER UNDER MPEP § 608.01(n)

MPEP § 608.01(n) states:

"the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Unfortunately, the MPEP test involves a circular reasoning, and is therefore less useful than the tests set forth in the relevant statute and rules. Specifically, the MPEP test indicates that incorporation of all of the limitations of the base claim is what determines whether a claim is a dependent claim. However, the statute clearly dictates that, by virtue of a claim being dependent, the claim must be construed to incorporate all of the limitations of the base claim.

However, in spite of the difficulty posed by this circular reasoning, it is respectfully submitted that Claim 7 is also proper under the MPEP test. As mentioned above, it is fully intended that Claim 7 incorporate all of the limitations of Claim 1. In other words, to infringe Claim 7, a computer readable medium must include instructions for performing each and every limitation recited in Claim 1.

To the extent that the three tests would yield different results, it is respectfully submitted that the outcome of the test set forth in the statute should govern. However, in the present case, it is respectfully submitted that all tests yield the same results; namely, that Claim 7 is a proper dependent claim. Thus, withdrawal of the 37 C.F.R. § 1.75(c) rejection is respectfully requested.

For the above reasons, withdrawal of the objections to the present Claims 17-32 is respectfully requested.

C. REJECTIONS OF CLAIMS 1-16 UNDER 35 U.S.C. § 101

Claims 1-16 have been rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

Independent Claim 1 has been amended herein to recite a “computer-implemented” method. Thus, Claim 1 is directed to statutory subject matter. For this reason the objection to Claim 1 under 35 U.S.C. § 101 is overcome. Further, Claims 2-16 depend from Claim 1, and therefore include each and every feature of the base claim. Thus, Claims 2-16 are also directed to statutory subject matter.

For the above reasons, withdrawal of the objections to Claims 1-16 under 35 U.S.C. § 101 is respectfully requested.

II. ISSUES RELATING TO THE PRIOR ART

A. INDEPENDENT CLAIM 1

Claim 1 has been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Lau et al., U.S. Patent Application Publication No. 2002/0184213 (“LAU”). The rejection is respectfully traversed.

Claim 1 comprises the features of:

...
wherein a plurality of attributes of said source are related to each other according to a first hierarchy that includes multiple hierarchical levels;
wherein a plurality of attributes of said target are related to each other according to a second hierarchy that includes multiple hierarchical levels;
wherein said commands establish, in said mapping, that a particular hierarchical level of said source is mapped to a particular hierarchical level of said target, wherein said particular hierarchical level of said source is at a different depth, within said first hierarchy, than the depth of said particular hierarchical level of said target within said second hierarchy; and
based on said commands, automatically generating a mapping scheme that represents said mapping,

It is respectfully submitted that LAU does not teach, describe, or suggest the feature of Claim 1 of receiving commands that establish a mapping in which a particular hierarchical level of the source is mapped to a particular hierarchical level of the target, where the particular

hierarchical level of the source is at a different depth in the first hierarchy than the depth of the particular hierarchical level of the target in the second hierarchy.

The Office Action asserts that the above feature is described in paragraphs [0079] and [0083] of LAU. This is incorrect.

In paragraph [0013], as well as in numerous other paragraphs (e.g. paragraphs [0013]-[0016], [0051]-[0052], [0060], [0062]-[0066]), LAU describes that upon receipt of mapping data, the LAU system generates a list of identified elements that are mapped from a target data instance to a source data instance. Significantly, the mapping between a target data instance and a source data instance described by LAU is based on identified elements, such as, for example, XML elements (i.e. this is element-to-element mapping, as shown in LAU's Fig. 6, lower-left pane). Nothing in LAU teaches, describes, or suggests the feature of Claim 1 of a mapping between a particular hierarchical level of a source and a particular hierarchical level of a target.

Further, in paragraph [0079] LAU describes that an “identity transformation is used for moving a **complete** portion of a data instance from the source data instance (i.e., a tree fragment) to the data instance or tree defined by the target file 308. The tree fragment may include nodes such as elements, attributes, comments, processing-instructions and text.” With respect to any i^{th} element of the list of identified elements (see paragraph [0076]), LAU describes in paragraph [0083] that if the i^{th} element in the target data instance is not mapped to a corresponding element in the source data instance, then a script is generated in a template that identifies the target element as a “new” element and the “new” element may be further be associated with a default value.

Thus, in paragraphs [0079] and [0083] LAU describes a transformation of data from a source data instance into a corresponding data in a target data instance. Significantly, however, the transformation is performed on an element-by-element basis, that is, complete elements (e.g.

a parent element and its children elements in the source tree) from the source data instance are transformed into complete elements (e.g. a parent element and its children elements in the target tree) of the target data instance. (See also LAU, paragraphs [0060]-[0066].) There is nothing in LAU that teaches, describes, or suggests that a set of sibling elements at a particular hierarchical level in a source tree fragment can be transformed on their own (independently of their parent element) into elements of a particular hierarchical level in a target tree fragment. Thus, LAU cannot possibly teach or suggest the feature of Claim 1 of a mapping between a particular hierarchical level of a source and a particular hierarchical level of a target.

In addition, since the transformations described in LAU are not based on a mapping of hierarchical levels, LAU cannot possibly even suggest, let alone describe, that a source hierarchical level can be mapped into a target hierarchical level of a different hierarchy depth.

In contrast, Claim 1 features a mapping in which a particular hierarchical level of a source is mapped to a particular hierarchical level of a target, where the particular hierarchical level of the source is at a different depth in the source hierarchy than the depth of the particular hierarchical level of the target in the target hierarchy.

For the reasons given above, LAU does not teach all of the features of Claim 1. Thus, it is respectfully submitted that Claim 1 is patentable under 35 U.S.C. § 102(e) over LAU. Reconsideration and withdrawal of the rejection of Claim 1 is respectfully requested.

B. DEPENDENT CLAIMS 2-32

Claims 2-32 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by LAU.

Each of Claims 2-32 depends directly or indirectly upon independent Claim 1, and therefore includes each and every feature of the independent base claim. Thus, each of Claims 2-

32 is allowable for the reasons given above for Claim 1. In addition, each of Claims 2-32 introduces one or more additional features that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those features is not included at this time. Therefore, it is respectfully submitted that Claims 2-32 are allowable for at least the reasons given above with respect to Claim 1.

III. CONCLUSION

The Applicant believes that all issues raised in the Office Action have been addressed. Further, for the reasons set forth above, the Applicant respectfully submits that allowance of the pending claims is appropriate. Reconsideration of the present application is respectfully requested in light of the amendments and remarks herein.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

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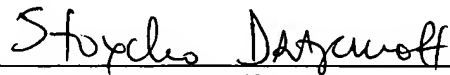
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A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm's check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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